

REMARKS1. The amendments.

The specification has been amended to delete a reference to the foreign priority document. This amendment is made in response to the Examiner's suggestion. Applicants continue to claim priority to Japanese patent application No. 2000-062755, filed March 7, 2000.

Claim 1 is amended to recite that the nonwoven fabric sheet is produced by *a process comprising piling filaments on a belt conveyor*, and then *peeling the sheet thus formed* from said belt by a roller. Support is found, for example, in the specification at page 11, lines 23-28. The "comprising" language is found in claim 2 as originally filed. A copy of the amended claim, showing the changes made, is provided in the attached Appendix.

2. Rejections under 35 USC §§ 102(b) or 103(a).

Claim 1 is rejected under 35 USC 102(b) as being anticipated by, or alternatively under 35 USC 103(a) as being obvious over Sabec, US patent 4,910,064 ("Sabec"). Applicants respectfully traverse for the reasons set forth below.

The Examiner states that claim 1 does not recite, and is not limited to, winding directly after piling and bonding.

Applicants begin by clarifying that the invention is clearly not limited to *winding* directly after piling, but rather to *peeling* directly after piling and bonding. For example, as disclosed in the specification, width-expanding rollers may be disposed between the roller that peels the fabric from the conveyor and the final roll of fabric, to produce the claimed fabric roll. See examples 2-4 (pp. 15-16), Figs. 1, 5, and 6, and Table 1 (p. 18). The use of width-expanding rollers actually serves to further reduce the tension with which the fabric roll is wound (specification, paragraph bridging pp. 7-8, and paragraph bridging pp. 9-10), and represents a preferred embodiment of the invention.

To address the Examiner's rejection, to the extent it also applies to the distinction of peeling directly after piling and bonding, Applicants have amended claim 1 to recite piling on a conveyor, and "peeling the sheet of nonwoven fabric thus formed *from said belt conveyor*". The piling step and the peeling step are thus related to the same conveyor. Applicants respectfully

submit that this recital distinguishes the claimed invention from Sabee, in which the piling step is conducted on a chill roller (see below), and in which peeling from a conveyor, if it takes place at all, occurs only after several intervening steps.

Applicants have argued that the claimed invention is also characterized by the limitation that the tension required to unroll the fabric is "0.25g/cm/basis weight or less", a limitation not disclosed by Sabee. The Examiner contends that this limitation is inherent, that it would "obviously have been present once the Sabee product is provided," citing *In re Best*, 195 USPQ 430, 443:

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludtke*, supra. Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685

Applicants respectfully point out that *In re Best* is relevant only where the claimed and prior art products are "identical or substantially identical, or are produced by identical or substantially identical processes". For example, the inherent unwinding tension of a roll of silk fabric would not invoke *In re Best*. *In re Best* is inapplicable here as well, because Applicant's claimed product is not substantially identical to prior art fabric rolls, nor is it made by a substantially identical process.

With regard to the identity of the products, Applicant's product is a roll of nonwoven fabric produced by simply piling and bonding filaments on a belt conveyor. Sabee describes this very process at column 4 lines 3-24, and characterizes it as a "prior art" process, and Sabee's product and process were found to be novel and non-obvious over this prior art. Applicants point out that Sabee's product is, in its simplest embodiment, a "non-woven web comprising a multiplicity of substantially longitudinally molecularly oriented continuous filaments ... and a multiplicity of melt blown fibers or filaments" deposited thereon. (See claim 1 of Sabee.) The fabric of the present invention, on the other hand, does not feature "substantially longitudinally

molecularly oriented continuous filaments." Furthermore, the melt-blown web may constitute as little as 3 to 5% of the final product of Sabee (see sentence bridging cols. 5 and 6), and this web is intended merely to stabilize the arrangement of continuous filaments (col. 5, lines 14-19), whereas the product of the instant invention consists entirely of the melt-blown web. For these reasons Applicants respectfully submit that the products are neither identical nor substantially identical.

With regard to the identity of the processes, Applicants again begin by noting that Sabee's process was determined to be novel and non-obvious over the prior art. Applicants next point out that the instant specification, in Table 1 (page 18), shows that the unwinding tension of the claimed fabric roll is a function of the position of the rotating roller(s) that peel the sheet from the conveyor (roller 2 in Fig. 1, 120 in Fig. 9). Reference Example 1 in Table 1 was prepared using the prior art apparatus of Fig. 9, whereas Examples 1-4 were prepared with the apparatus shown in Figs. 1, 4, 5, and 6, respectively (see specification, pp. 14-16). The apparatus of Sabee, upon examination of Figures 1, 2, and 14, is different in many respects from what is shown in any of the figures of the instant specification. Importantly, in Sabee's process, the piling of the melt-blown filaments 12' is not carried out on the conveyor, but on a "curtain" of longitudinally aligned filaments at or near the surface of chill roll 93 (see Fig. 6). For these reasons, Applicants respectfully submit that the process of Sabee is not substantially identical to the process of the instant invention.

Finally, the Examiner points to the following text in Sabee:

The stabilized web is pulled from the exit draw roll by a cross lapper, cross layer, heated embossing rolls, or a conventional winder, any of these methods being capable of applying various degrees of tension to the web depending upon the nature of the final product.

to support the contention that the present invention is anticipated or obvious in view of Sabee. Applicants respectfully point out that Sabee does not discuss controlling tension as the fabric is being removed from a conveyor, which is a recited feature of the present invention. Referring to Fig. 2 of Sabee, the stabilized web is formed by depositing melt-blown fibers on a curtain of filaments as it is taken up by a feed roll 67, and the web is then drawn on rolls 69, 71, and 73 and pulled from the exit draw roll 75 before being taken up on the conveyor 45. (Sabee, col. 15,

lines 49-57). Sabee makes no mention of the tension on the fabric as it is being peeled from the conveyor.

In summary, Applicants respectfully submit that the claimed fabric roll is neither identical nor substantially identical to the fabric roll of Sabee. Even assuming, *arguendo*, that the unwinding tension of a fabric roll produced by Sabee's process might be 0.25g/cm/basis weight or less, such a fact would neither anticipate nor make obvious the fabric rolls of the present invention, which are made in a very different way from a very different fabric. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §§ 102(b) or 103(a) in view of Sabee is respectfully requested.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants submit that the claims are in condition for allowance, and passage to issue is respectfully requested. The Examiner is invited to call Applicants' agents at the number below, if it would expedite the prosecution of the application.

Respectfully Submitted,

Morgan & Finnegan, LLP

By: _____

Kenichi Osawa

(Limited Recognition)

Dated: February 5, 2003

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone

APPENDIX

Claim 1, showing changes made:

1. (amended) A thermoplastic elastomer nonwoven fabric roll made by a process comprising piling and bonding thermoplastic elastomer filaments [into] onto a belt conveyor so as to form a sheet of nonwoven fabric, peeling the sheet of nonwoven fabric thus formed from said belt conveyor with a roller, and winding [the] said sheet of nonwoven fabric [thus formed] around a tube thereby forming a nonwoven fabric roll, characterized in that the tension required to unroll the nonwoven fabric from the nonwoven fabric roll is 0.25 g/cm/basis-weight or less.

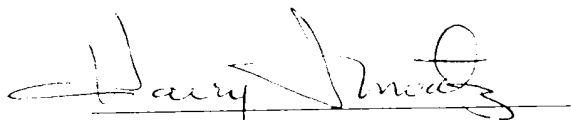
**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Kenichi Osawa is hereby given limited recognition under 37 CFR § 10.9(b), as an employee of the law firm of Morgan & Finnegan, LLP, to prepare and prosecute patent applications wherein the patent applicant is a client of the law firm of Morgan & Finnegan, LLP, and a registered practitioner, who is a member of the law firm of Morgan & Finnegan, LLP, is the practitioner of record in the applications. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Kenichi Osawa ceases to lawfully reside in the United States, (ii) Kenichi Osawa's employment with the law firm of Morgan & Finnegan, LLP, ceases or is terminated, or (iii) Kenichi Osawa ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such limited recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: June 3, 2003



Harry I. Moatz
Director of Enrollment and Discipline